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PATENT APPLICATION

ATTORNEY DOCKET NO. 10017961-2

IN THE
UNITED STATES PATENT AND TRADEMARK OFFICE

Inventor(s): Ronald P. Dean et al.

Confirmation No.: 4838

Application No.: 10/618,275

Examiner: T. Le

Filing Date: July 11, 2003

Group Art Unit: 3632

Title: DEFORMABLE MOUNTING BRACKET

Mail Stop Appeal Brief-Patents
Commissioner For Patents
PO Box 1450
Alexandria, VA 22313-1450

TRANSMITTAL OF AMENDED APPEAL BRIEF

Transmitted herewith is the Appeal Brief in this application with respect to the Notice of Appeal filed on 08/26/2005.

The fee for filing this Appeal Brief is (37 CFR 1.17(c)) 00.00

(complete (a) or (b) as applicable)

The proceedings herein are for a patent application and the provisions of 37 CFR 1.136(a) apply.

☐ (a) Applicant petitions for an extension of time under 37 CFR 1.136 (fees: 37 CFR 1.17(a)-(d)) for the total number of months checked below:

☐ 1st Month
\$120

☐ 2nd Month
\$450

☐ 3rd Month
\$1020

☐ 4th Month
\$1590

☐ The extension fee has already been filed in this application.

☐ (b) Applicant believes that no extension of time is required. However, this conditional petition is being made to provide for the possibility that applicant has inadvertently overlooked the need for a petition and fee for extension of time.

Please charge to Deposit Account 08-2025 the sum of \$ 00.00. At any time during the pendency of this application, please charge any fees required or credit any over payment to Deposit Account 08-2025 pursuant to 37 CFR 1.25. Additionally please charge any fees to Deposit Account 08-2025 under 37 CFR 1.16 through 1.21 inclusive, and any other sections in Title 37 of the Code of Federal Regulations that may regulate fees. A duplicate copy of this sheet is enclosed.

I hereby certify that this correspondence is being deposited with the U.S. Postal Service as Express Mail Airbill No. EV568255767US, in an envelope addressed to: MS Appeal Brief - Patents, Commissioner for Patents, PO Box 1450, Alexandria, VA 22313-1450, on the date shown below.

Date of Deposit: February 9, 2006

Typed Name: Donna Forbit

Signature: Donna Forbit

Respectfully submitted,

Ronald P. Dean et al.

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Docket No.: 10017961-2
(PATENT)

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In re Patent Application of:
Ronald P. Dean et al.

Application No.: 10/618,275

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For: DEFORMABLE MOUNTING BRACKET

Examiner: T. Le

AMENDED APPEAL BRIEF

MS Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

In response to the Notification of Non-Compliant Appeal Brief mailed on January 9, 2006, Appellant hereby submits this Amended Appeal Brief to replace the Appeal Brief filed on October 26, 2005. This Amended Appeal Brief makes the following modifications:

- The number of pending claims has been corrected in section III.A;
- Each paragraph of the summary of claimed subject matter identifies a corresponding independent claim. While identification of corresponding claims is not required by 37 C.F.R. § 41.37(c)(1)(v), Appellant believes that this amendment satisfies the Examiner's request;
- The heading "Grounds of Rejection to be Reviewed on Appeal" has been changed to "Issues to be Reviewed on Appeal." Although 37 C.F.R. § 41.37(c)(1) does not require that the exact headings listed in the rule be used (only "appropriate headings"), Appellant has changed this heading to more closely track the language of the Rule.
- The heading "Appendix A" has been changed to "Claims Appendix." Although 37 C.F.R. § 41.37(c)(1) does not require that the exact headings

listed in the rule be used (only “appropriate headings”), Appellant believes that this amendment satisfies the Examiner’s request. In addition, Applicant has removed Appendix B (“Evidence”) and Appendix C (“Related Proceedings”) as requested by the Examiner. However, Applicant notes that in unrelated cases, other Examiners have found Appeal Briefs non-compliant when such appendices were omitted, although no evidence or related proceedings were involved. Accordingly, Appellant respectfully requests that the Office adopt a uniform interpretation of the Rules with respect to Appeal Brief content; and

- The “Claims Appendix” lists only a copy of the claims involved in the Appeal, without status identifiers. While 37 C.F.R. § 41.37(c)(1)(viii) does not require that the appendix contain a copy of *only* the claims involved in the appeal and is completely silent regarding the use of status identifiers, Appellant believes that this amendment satisfies the Examiner’s request.

Moreover, Appellant believes that although items VIII (Claims), IX (Evidence), and X (Related Proceedings) are not specifically required by 37 C.F.R. § 41.37, the Rules do not forbid the use of such items in addition to the items mandated by § 41.37. Furthermore, these items are believed to provide helpful information to the Board when reviewing this Amended Appeal Brief. Therefore, Appellant has left these items in this Amended Appeal Brief, although their headings have been changed to “Claims Appendix,” “Evidence Appendix,” and “Related Proceedings Appendix,” respectively. If Appellee maintains that the Appeal Brief is non-compliant because of the inclusion of these items, Appellant respectfully requests that the Appellant provide authority for such a position. Accordingly, Appellant believes that the aforementioned modifications overcome the reasons for non-compliance put forth by the Examiner.

The fees required under § 41.20(b)(2) were dealt with in the Appeal Brief filed October 26, 2005. No further fees are believed to be due for this Amended Appeal Brief in response to the Notification of Non-Compliant Appeal Brief of January 9, 2006.

This brief contains items under the following headings as required by 37 C.F.R. § 41.37 and M.P.E.P. § 1206:

I.	Real Party In Interest
II	Related Appeals and Interferences
III.	Status of Claims
IV.	Status of Amendments
V.	Summary of Claimed Subject Matter
VI.	Issues to be Reviewed on Appeal
VII.	Argument
VIII.	Claims Appendix
IX.	Evidence Appendix
X.	Related Proceedings Appendix
	Claims Appendix

I. REAL PARTY IN INTEREST

The real party in interest for this appeal is:

Hewlett-Packard Development Company, L.P., a Texas Limited Partnership having its principal place of business in Houston, Texas.

II. RELATED APPEALS AND INTERFERENCES

There are no other appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in this appeal.

III. STATUS OF CLAIMS

A. Total Number of Claims in Application

There are 24 claims pending in application.

B. Current Status of Claims

1. Claims canceled: None
2. Claims withdrawn from consideration but not canceled: 17-20
3. Claims pending: 1-24
4. Claims allowed: None
5. Claims rejected: 1-16 and 21-24

C. Claims On Appeal

The claims on appeal are claims 1-16 and 21-24.

IV. STATUS OF AMENDMENTS

Appellant filed an Amendment in Response to Non-Final Office Action on May 5, 2005. The Examiner rejected Appellant's arguments in the Final Office Action mailed on July 29, 2005, to which Appellant has filed an Appeal. Appellant did not file an Amendment After Final Rejection. The Examiner issued a Notification of Non-Compliant Appeal Brief on January 9, 2006, to which Appellant has filed this Amended Appeal. The pending claims are enclosed in the Claims Appendix.

V. SUMMARY OF CLAIMED SUBJECT MATTER

The following provides a concise explanation of the subject matter defined in each of the independent claims involved in the appeal, referring to the specification by page and line number and to the drawings by reference characters, as required by 37 C.F.R.

§ 41.37(c)(1)(v). Each element of the claims is identified by a corresponding reference to the specification and drawings where applicable. Note that the citation to passages in the specification and drawings for each claim element does not imply that the limitations from the specification and drawings should be read into the corresponding claim element.

In one claimed embodiment, such as that of claim 1, a mounting bracket for a device (paragraph [0024]; figure 1, element 100) comprises a deforming element configured from a resiliently-deformable surface (paragraph [0028]; figure 1, elements 103 and 104), where the deforming element increases a deformability of the resiliently-deformable surface (paragraph [0029]), and a pair of attachment members disposed on opposite sides of and attached to the surface and adapted to interface with the device upon deformation of the deforming element (paragraph [0025]; figure 1, elements 101).

In another claimed embodiment, such as that of claim 21, a system for dissipating heat in a computer-mounted device (paragraph [0023]) comprises a mounting bracket constructed from a thermal conductor (paragraph [0024]; figure 1, element 100), sidewalls on the mounting bracket constructed from the thermal conductor (paragraph [0025]; figure 1, elements 101), fastening receptacles within the sidewalls for securing the computer-mounted

device in relation to a computer (paragraph [0026]; figure 1, elements 102), where the fastening creates a thermal interface between the computer-mounted device and the sidewalls (paragraph [0031]; figure 1, elements 105).

VI. ISSUES TO BE REVIEWED ON APPEAL

Whether claims 1-7, 10-16, and 21-23 are properly rejected under 35 U.S.C. § 102(b) as being anticipated by Joss et al. (U.S. Patent No. 5,823,495, hereinafter *Joss*).

Whether claims 1-4, 6-9, 12, 21, and 24 are properly rejected under 35 U.S.C. § 102(b) as being anticipated by Ramsdell (U.S. Patent No. 5,344,032, hereinafter *Ramsdell*).

VII. ARGUMENT

Appellant respectfully traverses the outstanding rejections of the pending claims, and requests that the Board reverse these rejections in light of the remarks contained herein. Appellant respectfully asserts that separately argued claims do not stand or fall together, *see* 37 C.F.R. § 41.37(c)(1)(vii). Furthermore, Appellant has proposed submitting a terminal disclaimer in compliance with 37 C.F.R. § 1.321(c) if the obviousness-type double patenting rejection of claims 1-9, 12-16, 21, and 24 over claims 1-17 of United States patent number 6,666,414 stands upon indication that the claims are allowable.

A. Claim Rejections Under 35 U.S.C. § 102 Over *Joss*

Claims 1-7, 10-16, and 21-23 are rejected under 35 U.S.C. § 102(b) as being anticipated by *Joss*. In order to anticipate a claim under 35 U.S.C. § 102, a single reference must teach each and every element of the claim. *See Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631 (Fed. Cir. 1987). Appellant respectfully submits that *Joss* fails to teach each and every element of claims 1-7, 10-16, and 21-23, and respectfully requests that this rejection be overturned.

1. Independent Claim 1 and Dependent Claims 2 and 13

Claim 1 recites, in part, “a deforming element configured from a resiliently-deformable surface, wherein said deforming element increases a deformability of said resiliently-deformable surface.” In rejecting claim 1 over *Joss*, the Examiner relies upon

middle section 120 of spring 118 to meet the deforming element and planar surface 104 to meet the resiliently-deformable surface. Final Office Action, page 3. However, spring 118 of *Joss* is not a portion of planar surface 104. Instead, spring 118 is attached to surface 104 via rivet 130. *Joss*, col. 2, lines 54-56; figure 1. Hence the elements of *Joss* relied upon by the Examiner are different structures from those required by claim 1.

In response to Appellant's arguments, the Examiner has maintained his position that *Joss* teaches a deformable element which can increase the deformability of a resiliently-deformable surface. Final Office Action, page 7. However, *Joss*' spring 118 merely "dampen[s] vibration, mechanical shock, etc. imparted to mobile radio via planar surface 104." *Joss*, col. 2, lines 61-63. The Examiner has not attempted to explain how spring 118 increases the deformability of planar surface 104, and Appellants assert that it does not.

The Examiner has further contended that:

the phrase beginning with 'wherein' is merely a functional expression equivalent to 'whereby' clause which does not define any structure and accordingly can not serve to distinguish and thus could have patentable significance. The phrase beginning with 'configured' also does not distinguish the claimed invention from prior art as how it can be configured or what may be configured in order to distinguish from the prior art. Final Office Action, page 8.

The deforming element of claim 1 is configured from a surface so as to increase the deformability of the surface. Appellant asserts that a recitation of the manner in which the deforming element is configured from the surface is a structural, rather than a functional, limitation.

Even if claim 1 recited functional limitations, Appellant asserts that the claim would have to be considered as a whole. *See Diamond v. Diehr*, 450 U.S. 175, 188 (1981). Functional language does not, in and of itself, render a claim improper. *See In re Swinehart*, 439 F.2d 210, 169 USPQ 226 (CCPA 1971). In fact, Office policy requires that functional limitations be evaluated and considered just like any other limitation of the claim. *See* M.P.E.P. § 2173.05(g). Functional limitations such as "members adapted to be positioned" and "portions ... being resiliently dilatable whereby said housing may be slidably positioned" have been found to precisely define structural attributes of interrelated component parts. *In*

re Venezia, 530 F.2d 956, 189 USPQ 149 (CCPA 1976). Therefore, the Examiner has improperly disregarded limitations recited in claim 1.

Finally, the Examiner states that “[Appellant] appears to emphasis [sic] the difference based on the intended use of the invention.” Final Office Action, page 8. Instead, however, Appellant has pointed to significant structural differences between *Joss* and the claimed elements. For instance, as noted above, *Joss* does not teach or suggest a deforming element configured from a resiliently-deformable surface so as to increase the deformability of the resiliently-deformable surface. Accordingly, the elements recited in claim 1 are structurally different from those taught or suggested by *Joss*.

Therefore, claim 1 is not anticipated by *Joss*. As such, Appellant respectfully requests that this rejection of claim 1 be overturned.

Claims 2 and 13 depend from independent claim 1, and thus inherit all of the elements of that independent claim. Therefore, for at least the reasons advanced above in addressing the rejection of claim 1, Appellant respectfully asserts that claims 2 and 13 set forth features and elements not taught or suggested by *Joss*. Thus, Appellant respectfully asserts that claims 2 and 13 are patentable over the rejection of record.

2. Dependent Claim 3

Dependent claim 3 depends from independent claim 1, and thus inherits all of the limitations of that independent claim. It is respectfully submitted that dependent claim 3 is allowable at least because of its dependency from independent claim 1 for the reasons discussed above.

Moreover, dependent claim 3 further recites, in part, a “deforming element compris[ing] one or more compression elements.” The Examiner relies upon middle section 120 of spring 118 as meeting the claimed “deforming element,” and on first end 122 of spring 118 as meeting the claimed “one or more compression elements.” Final Office Action, pages 3-4. However, first end 122 is a spring stopping mechanism, and not a compression element. *Joss*, col. 2, lines 54-61. Therefore, claim 3 is patentable over the rejection of record.

3. Dependent Claim 4

Dependent claim 4 depends from independent claim 1, and thus inherits all of the limitations of that independent claim. It is respectfully submitted that dependent claim 4 is allowable at least because of its dependency from independent claim 1 for the reasons discussed above.

Moreover, dependent claim 4 further recites, in part, a “deforming element compris[ing] a serpentine metal strip.” The Examiner relies upon the middle section 120 of *Joss*’ spring 118 as meeting the claimed “deforming element.” Final Office Action, page 4. However, *Joss* does not teach or suggest that middle section 120 is a serpentine metal strip. Therefore, claim 4 is patentable over the rejection of record.

4. Dependent Claim 5

Dependent claim 5 depends from independent claim 1, and thus inherits all of the limitations of that independent claim. It is respectfully submitted that dependent claim 5 is allowable at least because of its dependency from independent claim 1 for the reasons discussed above.

Moreover, dependent claim 5 further recites, in part, a “deforming element compris[ing] a portion of said surface adapted to provide a spring element.” The Examiner has relied upon middle section 120 of spring 118 as meeting the claimed “deforming element” and upon planar surface 104 as meeting the claimed “surface.” Final Office Action, page 3. However, middle section 120 is not a portion of planar surface 104. Instead, middle section 120 is attached to surface 104 via rivet 130. *Joss*, col. 2, lines 54-56; figure 1. As such, the deforming element of *Joss* does not comprise a portion of the surface, as recited in claim 5. Therefore, claim 5 is patentable over the rejection of record.

5. Dependent Claim 6

Dependent claim 6 depends from independent claim 1, and thus inherits all of the limitations of that independent claim. It is respectfully submitted that dependent claim 6 is allowable at least because of its dependency from independent claim 1 for the reasons discussed above.

Moreover, dependent claim 6 further recites, in part, that the “deforming element is adapted to provide linear deformation of said surface.” Again, the Examiner has relied upon middle section of spring 118 as meeting the claimed “deforming element” and upon planar surface 104 as meeting the claimed “surface.” Final Office Action, page 3. However, middle section 120 of spring 118 is perpendicularly attached to surface 104 via rivet 130, and as such it is not adapted to provide linear deformation of surface 104. *Joss*, figure 1. Moreover, *Joss* only teaches that spring 118 is deformable, but not surface 104, which is substantially planar. *Joss*, col. 2, lines 2-3. Therefore, claim 6 is patentable over the rejection of record.

6. Dependent Claim 7

Dependent claim 7 depends from independent claim 1, and thus inherits all of the limitations of that independent claim. It is respectfully submitted that dependent claim 7 is allowable at least because of its dependency from independent claim 1 for the reasons discussed above.

Moreover, dependent claim 7 further recites, in part, that the “deforming element of said surface is compressed to bring said attachment members into contact with said device.” The Examiner has relied upon middle section 120 of spring 118 as meeting the claimed “deforming element” and upon attachment tabs 106 as meeting the claimed “attachment members.” Final Office Action, page 3. However, compression of spring 118 does not bring attachment tabs 106 in contact with the device. In fact, the relative position of each attachment tab 106 is determined by the width of mounting apparatus 100 and thus is not affected by the operation of middle section 120. *Joss*, figure 1. Therefore, claim 7 is patentable over the rejection of record.

7. Dependent Claim 10

Dependent claim 10 depends from independent claim 1, and thus inherits all of the limitations of that independent claim. It is respectfully submitted that dependent claim 10 is allowable at least because of its dependency from independent claim 1 for the reasons discussed above.

Moreover, dependent claim 10 further recites, in part, “a thermal interface material disposed between said attachment members and said device.” The Examiner relies upon

Joss' pad 114 as meeting this limitation. Office Action, page 4. At the passage cited by the Examiner, *Joss* discloses that:

“[p]ad 114 . . . act[s] to dampen any vibration, mechanical shock, etc. imparted to the mobile radio via the attachment tab. Although we prefer that pad 114 be constructed from a compliant elastomeric material, any composition with desired dampening properties is a potential candidate.” *Joss*, col. 2, lines 47-53.

Appellants can find no teaching or suggestion in the above-cited passage or elsewhere that pad 114 be made from a thermal interface material.

Nevertheless, in response to Appellant's arguments, the Examiner has maintained his position that “a compliant elastomeric material or any composition with desired damping properties . . .” is compatible with a thermal interface material . . .” Final Office Action, page 8. Appellant asserts that, if pad 114 is made of elastomeric materials for damping purposes as proposed by *Joss*, it will generally present an insulating layer, not a thermal interface. Again, Appellant can find no teaching or suggestion of a thermal interface in *Joss*. Therefore, claim 10 is patentable over the rejection of record.

8. Dependent Claim 11

Dependent claim 11 depends directly from dependent claim 10 and indirectly from independent claim 1, and thus inherits all the limitations of those claims. It is respectfully submitted that dependent claim 11 is allowable at least because of its dependency from independent claim 1 and from dependent claim 10 for the reasons discussed above.

Moreover, dependent claim 11 further recites, in part, “a thermally-conductive elastomer sheet material.” As noted above, Appellant is aware that *Joss* teaches the use of elastomeric materials for damping purposes. *Joss*, col. 2, lines 47-53. However, the claimed thermally-conductive elastomeric material is not the same as *Joss*' elastomeric material. More specifically, the claimed thermally-conductive elastomeric material creates a thermal interface, whereas the elastomeric material of *Joss* presents an insulating layer. Furthermore, there is no reason why *Joss* would need to use a thermally-conductive elastomer merely to attenuate mechanical vibrations. Therefore, claim 11 is patentable over the rejection of record.

9. Dependent Claim 12

Dependent claim 12 depends from independent claim 1, and thus inherits all of the limitations of that independent claim. It is respectfully submitted that dependent claim 12 is allowable at least because of its dependency from independent claim 1 for the reasons discussed above.

Moreover, dependent claim 12 further recites, in part, “a computer storage device.” Appellant asserts that *Joss* only teaches a mounting apparatus for securing a mobile radio, and not a computer storage device. *Joss*, Abstract. Nonetheless, the Examiner has not considered the patentability of this claim and has stated that “[claim 12] recites an intended use as set out in the preamble, which has [been] given no patentable weight.” Final Office Action, page 4. Appellant points out that claim 12 recites express limitations in the body of the claim, not in the preamble. Moreover, claim 12 recites a structure, and not an intended use. Therefore, the Examiner has improperly disregarded limitations recited in claim 12. Accordingly, claim 12 is patentable over the rejection of record.

10. Dependent Claim 14

Dependent claim 14 depends indirectly from independent claim 1, and thus inherits all of the limitations of that independent claim. It is respectfully submitted that dependent claim 14 is allowable at least because of its dependency from independent claim 1 for the reasons discussed above.

Moreover, dependent claim 14 further recites, in part, a “resiliently-deformable surface . . . deformed by action of screws inserted through said screw holes into said device.” The Examiner has relied upon planar surface 104 as meeting the claimed “surface.” Final Office Action, page 3. However, there is no teaching or suggestion in *Joss* that planar surface 104 may be deformed by action of screws 116 inserted through holes 112, as required by claim 14. *Joss*, figure 1. Therefore, claim 14 is patentable over the rejection of record.

11. Dependent Claim 15

Dependent claim 15 depends from independent claim 1, and thus inherits all of the limitations of that independent claim. It is respectfully submitted that dependent claim 15 is

allowable at least because of its dependency from independent claim 1 for the reasons discussed above.

Moreover, dependent claim 15 further recites a “resiliently-deformable surface compris[ing] a compressible lateral midline portion connecting opposing outer lateral portions of said surface.” The Examiner relies upon *Joss*’ receiving portion 108 or, alternatively, upon the middle section 120 of spring 118 as meeting this limitation. Final Office Action, page 5. First, Appellant asserts that neither *Joss*’ receiving portion 108 nor middle section 120 has a compressible lateral midline portion connecting opposing outer lateral portions. *Joss*, figure 1. Second, Appellant notes that the Examiner has previously relied upon planar surface 104 as meeting the resiliently-deformable surface recited in independent claim 1, from which dependent claim 15 depends. Office Action, page 3. Thus, the Examiner’s subsequent reliance upon receiving portion 108 and middle section 120 as meeting the same limitation is improper because the claimed “surface” cannot be simultaneously met by both planar surface 104 *and* receiving portion 108 or middle section 120. Therefore, claim 15 is patentable over the rejection of record.

12. Dependent Claim 16

Dependent claim 16 depends from independent claim 1, and thus inherits all of the limitations of that independent claim. It is respectfully submitted that dependent claim 16 is allowable at least because of its dependency from independent claim 1 for the reasons discussed above.

Moreover, dependent claim 16 further recites a “resiliently-deformable surface includ[ing] a flat spring midline portion connecting opposing outer lateral portions of said surface.” The Examiner relies upon the middle section 120 of *Joss*’ spring 118 as meeting this limitation. Final Office Action, page 5. However, middle section 120 of spring 118 does not connect opposing outer lateral portions of surface 104. *Joss*, figure 1. Therefore, claim 16 is patentable over the rejection of record.

13. Independent Claim 21

Claim 21 recites “[a] system for dissipating heat in a computer-mounted device . . .” and “securing said computer-mounted device in relation to a computer” The Examiner

relies upon the disclosure of *Joss* to meet this claim. Final Office Action, page 5. However, *Joss* only teaches a mounting apparatus for securing a mobile radio. *Joss*, Abstract. Accordingly, *Joss* is insufficient to meet the claim under 35 U.S.C. § 102.

Moreover, claim 21 recites that “said fastening creates a thermal interface between said computer-mounted device and said sidewalls.” The Examiner contends that *Joss* provides fastening that creates a thermal interface between the device and the sidewalls. Final Office Action, page 5. However, *Joss* teaches the use of pads 114 adhesively affixed to attachment tabs 106. *Joss*, col. 2, lines 44-46. The use of such pads and adhesive presents an insulating layer, not a thermal interface. There is nothing in the disclosure of *Joss* to teach or suggest that pads 114 and the adhesive used therewith is compatible with creating a thermal interface as recited in the claim. Accordingly, the identical invention is not shown by *Joss* in as complete detail as is contained in the claim.

14. Dependent Claim 22

Dependent claim 22 depends from independent claim 21, and thus inherits all of the limitations of that independent claim. It is respectfully submitted that dependent claim 22 is allowable at least because of its dependency from independent claim 21 for the reasons discussed above.

Moreover, dependent claim 22 further recites, in part, “a conduction layer disposed on said sidewalls” Again, the Examiner relies upon *Joss*’ pad 114 as meeting this limitation. However, as noted above, *Joss* teaches that:

[p]ad 114 . . . act[s] to dampen any vibration, mechanical shock, etc. imparted to the mobile radio via the attachment tab. Although we prefer that pad 114 be constructed from a compliant elastomeric material, any composition with desired dampening properties is a potential candidate.” *Joss*, col. 2, lines 47-53.

Appellant can find no teaching or suggestion in the above-cited passage or elsewhere that pad 114 may be a conduction layer. As a matter of fact, if pad 114 is made of elastomeric materials for damping purposes as proposed by *Joss*, it will generally present an insulating layer, not a conduction layer. Therefore, claim 22 is patentable over the rejection of record.

15. Dependent Claim 23

Dependent claim 23 depends directly from dependent claim 22 and indirectly from independent claim 21, and thus inherits all the limitations of those claims. It is respectfully submitted that dependent claim 23 is allowable at least because of its dependency from independent claim 21 and from dependent claim 22 for the reasons discussed above.

Moreover, dependent claim 23 further recites, in part, a “conduction layer compris[ing] a thermally-conductive elastomer sheet.” The Examiner contends *Joss* teaches an elastomer. Final Office Action, page 5. However, *Joss* does not teach a thermally-conductive elastomer. *Joss*, col. 2, lines 47-53. Therefore, claim 23 is patentable over the rejection of record.

B. Claim Rejections Under 35 U.S.C. § 102 Over *Ramsdell*

Claims 1-4, 6-9, 12, 21, and 24 are rejected under 35 U.S.C. § 102(b) as being anticipated by *Ramsdell*. In order to anticipate a claim under 35 U.S.C. § 102, a single reference must teach each and every element of the claim. See *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631 (Fed. Cir. 1987). Appellant respectfully submits that *Ramsdell* fails to teach each and every element of claims 1-4, 6-9, 12, 21, and 24, and respectfully requests that this rejection be overturned.

1. Independent Claim 1 and Dependent Claims 3 and 7

Claim 1 recites, in part, “a deforming element configured from a resiliently-deformable surface, wherein said deforming element increases a deformability of said resiliently-deformable surface” The Examiner relies upon liner 20 of *Ramsdell* to meet the deforming element and, although stating that *Ramsdell* teaches that liner 20 is configured from a resiliently-deformable surface, provides no information with respect to what part of *Ramsdell* is relied upon to meet the resiliently-deformable surface. Final Office Action, page 5. Liner 20, however, is not shown in *Ramsdell* to increase a deformability of a resiliently-deformable surface, nor has the Examiner shown otherwise.

Claim 1 further recites, in part, “a pair of attachment members disposed on opposite sides of and attached to said surface and adapted to interface with the device upon deformation of said deforming element.” The Examiner simply relies upon cover 19 to meet

the attachment members and does not indicate which structure is believed to meet the claimed surface. Final Office Action, page 5. Appellant initially notes that only a single cover 19 is provided with respect to liner 20, and thus “a pair of attachment members disposed on opposite sides of and attached to said surface” is not shown. Moreover, cover 19 is not shown by *Ramsdell* to interface with the gun upon deformation of liner 20. In contrast, it appears that liner 20 is disposed to prevent a gun inserted therein from interfacing with cover 19 of *Ramsdell*. Accordingly, the elements of *Ramsdell* relied upon are structurally different from those recited in the claim.

Therefore, claim 1 is not anticipated by *Ramsdell*. As such, Appellant respectfully requests that this rejection of claim 1 be overturned.

Additionally, each of dependent claims 3 and 7 depend either directly or indirectly from independent claim 1, and thus inherit all limitations of independent claim 1. It is respectfully submitted that dependent claims 3 and 7 are allowable at least because of their dependency from independent claim 1 for the reasons discussed above.

2. Dependent Claim 2

Dependent claim 2 depends from independent claim 1, and thus inherits all of the limitations of that independent claim. It is respectfully submitted that dependent claim 2 is allowable at least because of its dependency from independent claim 1 for the reasons discussed above.

Moreover, dependent claim 2 recites, in part, “attachment members compris[ing] fastener attachment sites for receiving fasteners for interfacing said attachment members with the device upon deformation of said deforming element.” The Examiner has relied upon cover 19 and core 18 as meeting the claimed “attachment members” and “attachment sites,” respectively. Final Office Action, pages 5-6. However, cover 19 does not include core 18. In fact, these are different structural elements made of entirely different materials. *Ramsdell*, col. 2, lines 6-16. Therefore, claim 2 is patentable under over the rejection of record.

3. Dependent Claim 4

Dependent claim 4 depends from independent claim 1, and thus inherits all of the limitations of that independent claim. It is respectfully submitted that dependent claim 4 is allowable at least because of its dependency from independent claim 1 for the reasons discussed above.

Moreover, dependent claim 4 recites, in part, a “deforming element compris[ing] a serpentine metal strip.” The Examiner has relied upon liner 20 as meeting the claimed “deforming element.” Final Office Action, page 5. However, *Ramsdell* does not teach or suggest that middle section 120 may be a serpentine metal strip. Therefore, claim 4 is patentable under over the rejection of record.

4. Dependent Claim 6

Dependent claim 6 depends from independent claim 1, and thus inherits all of the limitations of that independent claim. It is respectfully submitted that dependent claim 6 is allowable at least because of its dependency from independent claim 1 for the reasons discussed above.

Moreover, dependent claim 6 recites, in part, that the “deforming element is adapted to provide linear deformation of said surface.” Again, the Examiner has relied upon liner 20 of *Ramsdell* to meet the deforming element but has provided no information with respect to what part of *Ramsdell* is relied upon to meet the resiliently-deformable surface. Final Office Action, page 5. Appellant asserts that liner 20 is not adapted to provide linear deformation of a surface, as required by claim 6. Therefore, claim 6 is patentable over the rejection of record.

5. Dependent Claim 8

Dependent claim 8 depends from independent claim 1, and thus inherits all of the limitations of that independent claim. It is respectfully submitted that dependent claim 8 is allowable at least because of its dependency from independent claim 1 for the reasons discussed above.

Moreover, dependent claim 8 recites, in part, a “deforming element . . . comprised of machined aluminum alloy.” Appellant asserts that *Ramsdell* teaches a core 18 composed of an aluminum alloy. Final Office Action, page 6. However, *Ramsdell* does not teach or suggest a deforming element comprised of a “machined aluminum alloy,” as required by claim 8. Therefore, claim 8 is patentable under over the rejection of record.

6. Dependent Claim 9

Dependent claim 9 depends from independent claim 1, and thus inherits all of the limitations of that independent claim. It is respectfully submitted that dependent claim 9 is allowable at least because of its dependency from independent claim 1 for the reasons discussed above.

Moreover, dependent claim 9 recites, in part, that “attachment members are comprised of aluminum alloy.” The Examiner has relied upon cover 19 as meeting the claimed “attachment members.” Final Office Action, page 5. At the passage cited by the Examiner, *Ramsdell* teaches:

a core 18 composed of a strip of deformable material. The preferred material is an aluminum alloy such as "Duralumin" which is usually stiff enough to hold its shape in the U-form shown, but which can be bent enough to be deformed to match varying sizes of gun stocks. *A padded and foamed material such as a foamed rubber is used to create a cover 19 for the edges and the inner surface of the U-shape so that the part of the gun being held will not be damaged by direct contact with the metal of the bracket.* *Ramsdell*, col. 2, lines 6-16 (emphasis added).

Thus, core 18 is composed of an aluminum alloy. However, cover 19, which is the element of *Ramsdell* relied upon by the Examiner as meeting the “attachment members” of claim 9, is comprised of a padded and foamed material. Therefore, claim 9 is patentable under over the rejection of record.

7. Dependent Claim 12

Dependent claim 12 depends from independent claim 1, and thus inherits all of the limitations of that independent claim. It is respectfully submitted that dependent claim 12 is

allowable at least because of its dependency from independent claim 1 for the reasons discussed above.

Moreover, dependent claim 12 recites, in part, “a computer storage device.” Appellant asserts that *Ramsdell* only teaches a mounting apparatus for holding a gun, and not a computer storage device. *Ramsdell*, Title and Abstract. Nonetheless, the Examiner has not considered the patentability of this claim and has stated that “[claim 12] recites an intended use as set out in the preamble, which has [been] given no patentable weight.” Final Office Action, page 6. Appellant points out that claim 12 recites express limitations in the body of the claim, not in the preamble. Moreover, claim 12 recites a structure, and not an intended use. Therefore, the Examiner has improperly disregarded limitations recited in claim 12. Accordingly, claim 12 is patentable over the rejection of record.

8. Independent Claim 21 and Dependent Claim 24

Claim 21 recites “[a] system for dissipating heat in a computer-mounted device” and “securing said computer-mounted device in relation to a computer” The Examiner relies upon the disclosure of *Ramsdell* to meet this claim, although the rejection of record omits reference to a computer-mounted device and a computer, see the Office Action at page 7. The Examiner is respectfully reminded that, when evaluating the scope of a claim, the claim must be considered as a whole. See *Diamond v. Diehr*, 450 U.S. 175, 188 (1981). As express limitations of the claim have not been addressed by the rejection of record, a *prima facie* showing of anticipation under 35 U.S.C. § 102 has not been made.

Moreover, claim 21 recites that “said fastening creates a thermal interface between said computer-mounted device and said sidewalls.” *Ramsdell* is directed to a gun holder for vehicles. *Ramsdell*, Abstract. *Ramsdell* does not teach a thermal interface between the gun and the holder, nor would anyone of ordinary skill in the art be lead to such a thermal interface from reviewing *Ramsdell* without the benefit of hindsight from Appellant’s disclosure. Accordingly, *Ramsdell* is insufficient to anticipate the claim under 35 U.S.C. § 102.

Therefore, claim 21 is not anticipated by *Ramsdell*. As such, Appellant respectfully requests that this rejection of claim 21 be overturned.

In addition, dependent claim 24 depends from independent claim 21, and thus inherits all of the limitations of that independent claim. It is respectfully submitted that dependent claim 24 is allowable at least because of its dependency from independent claim 21 for the reasons discussed above.

VIII. CLAIMS APPENDIX

A copy of the claims involved in the present appeal is attached hereto as Claims Appendix. As indicated above, the Claims Appendix do include the amendments filed by Appellant on May 5, 2005.

IX. EVIDENCE APPENDIX

No evidence pursuant to §§ 1.130, 1.131, or 1.132 or entered by or relied upon by the examiner is being submitted. Accordingly, no Evidence Appendix is attached hereto.

X. RELATED PROCEEDINGS APPENDIX

No related proceedings are referenced in II. above. Accordingly, copies of decisions of related proceedings are not provided, and no Related Proceedings Appendix is attached hereto.

I hereby certify that this correspondence is being deposited with the U.S. Postal Service as Express Mail Airbill No. EV568255767US, in an envelope addressed to: MS Appeal Brief - Patents, Commissioner for Patents, PO Box 1450, Alexandria, VA 22313-1450, on the date shown below.

Date of Deposit: February 9, 2006

Typed Name: Donna Forbit

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Respectfully submitted,

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Date: February 9, 2006

CLAIMS APPENDIX

Claims Involved in the Appeal of Application Serial No. 10/618,275:

1. A mounting bracket for a device comprising:
a deforming element configured from a resiliently-deformable surface, wherein said deforming element increases a deformability of said resiliently-deformable surface; and
a pair of attachment members disposed on opposite sides of and attached to said surface and adapted to interface with the device upon deformation of said deforming element.
2. The mounting bracket according to claim 1 wherein said each of said attachment members comprises fastener attachment sites for receiving fasteners for interfacing said attachment members with the device upon deformation of said deforming element.
3. The mounting bracket according to claim 1 wherein said deforming element comprises one or more compression elements.
4. The mounting bracket according to claim 1 wherein said deforming element comprises a serpentine metal strip.
5. The mounting bracket according to claim 1 wherein said deforming element comprises a portion of said surface adapted to provide a spring element.
6. The mounting bracket according to claim 1 wherein said deforming element is adapted to provide linear deformation of said surface.
7. The mounting bracket according to claim 1 wherein said deforming element of said surface is compressed to bring said attachment members into contact with said device.
8. The mounting bracket according to claim 1 wherein said deforming element is comprised of machined aluminum alloy.
9. The mounting bracket according to claim 1 wherein said attachment members are comprised of aluminum alloy.

10. The mounting bracket according to claim 1 further comprising:
a thermal interface material disposed between said attachment members and said device.
11. The mounting bracket according to claim 10 wherein said thermal interface material is a thermally-conductive elastomer sheet material.
12. The mounting bracket according to claim 1 wherein said device is a computer storage device.
13. The mounting bracket according to claim 1 further comprising screw holes defined in said attachment members.
14. The mounting bracket according to claim 13 wherein said resiliently-deformable surface is deformed by action of screws inserted through said screw holes into said device.
15. The mounting bracket according to claim 1 wherein said resiliently-deformable surface comprises a compressible lateral midline portion connecting opposing outer lateral portions of said surface.
16. The mounting bracket according to claim 1 wherein said resiliently-deformable surface includes a flat spring midline portion connecting opposing outer lateral portions of said surface.
21. A system for dissipating heat in a computer-mounted device comprising:
a mounting bracket constructed from a thermal conductor;
sidewalls on said mounting bracket constructed from said thermal conductor;
fastening receptacles within said sidewalls for securing said computer-mounted device in relation to a computer, wherein said fastening creates a thermal interface between said computer-mounted device and said sidewalls.
22. The system of claim 21 further comprising a conduction layer disposed on said sidewalls, wherein said conduction layer is disposed between said sidewalls and said computer-mounted device when said device is fastened to said sidewalls.

23. The system of claim 22 wherein said conduction layer comprises a thermally-conductive elastomer sheet.

24. The system of claim 21 wherein said thermal conductor comprises aluminum alloy.